

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/619,553 Confirmation No. : 5934
First Named Inventor : Klemens DWORATZEK
Filed : July 16, 2003
TC/A.U. : 3747
Examiner : M.J.McMahon

Docket No. : 037141.52545US
Customer No. : 23911

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Title : Valve for Controlling a Fluid Flow

REPLY TO OFFICE ACTION

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply to the Office Action mailed January 28, 2005 in the above-identified patent application.

Responsive to the requirement for restriction, applicants hereby provisionally elect the claims of Group I, namely valve claims 1-17, for examination in the instant application in the event the restriction requirement is not withdrawn. This provisional election is made with traverse.

The requirement for restriction is respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested.

The requirement for restriction is erroneous because it mistakenly characterizes the relationship between the two groups of claims. The Office Action incorrectly states that the two alleged inventions are related as subcombinations useable together. Instead, the two groups of claims are related as combination and subcombination. See MPEP §806.05(a). The filter device (combination) of claims 18-20 expressly requires a valve (subcombination) "according to claim 1". Thus the claimed subcombination (valve) is an essential distinguishing feature of the combination (filter system), and a requirement for restriction should not be made, even though the valve may have separate utility. See MPEP §806.05(c). It follows that claim 1 cannot be restricted away from claims 18-20. Indeed, if the valve of claim 1 is found patentable, the filter system of claims 18-20 will necessarily also be patentable. Therefore, the requirement for

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restriction is not justified, and reconsideration and withdrawal thereof are respectfully requested.

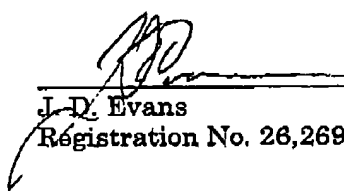
Favorable action on the application is earnestly solicited.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 037141.52545US).

Respectfully submitted,

February 28, 2005


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CERTIFICATE OF FACSIMILE TRANSMISSION

The undersigned hereby certifies that this REPLY TO OFFICE ACTION is being transmitted to the U.S. Patent and Trademark Office by facsimile transmission to (703) 872-9306 this 28th day of February 2005.


J. D. Evans